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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,927	07/28/2003	Valeriano Merli	12670/60803	7695

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New York, NY 10004-1050

EXAMINER

AULAKH, CHARANJIT

ART UNIT	PAPER NUMBER
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1625

DATE MAILED: 05/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/628,927	Applicant(s) MERLI ET AL.	
	Examiner Charanjit S. Aulakh	Art Unit 1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) 1-19 and 37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 20 and 31-36 is/are rejected.
- 7) ☒ Claim(s) 21-30 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. <u>04/28/04</u> . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

1. Claims 1-37 are pending in the application.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-13, drawn to compounds of formula (II) and a process for preparing these compounds, classified in class 546, subclass 79.
- II. Claims 14-19 and 37, drawn to compounds of formula (IV) and a process for preparing these compounds, classified in class 546, subclass 80.
- III. Claims 20-36, drawn to a process for preparing compounds of formula (I), classified in class 546, subclass 82.

3. The inventions I, II and III as defined above are patentably distinct, each from the other since they are structurally so divergent that a reference showing compounds of invention I would not render compounds of invention II or III prima facie obvious. Search required for e.g ; compounds of invention I in class 546, subclass 79 is not the same search required for e.g ; compounds of invention II in class 546, subclass 80 and therefore, constitutes a burdensome search.

4. During a telephone conversation with the applicant's attorney, Ms. Amy Hulina on April 28, 2004, a provisional election was made with traverse to prosecute the invention of group III, claims 20-36. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-19 and 37 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

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5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 20 and 31-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 20, page 21, line 2 from top, alkyl should be changed to alkenyl since the substituents for alkyl are already defined.

In claim 31, page 24, line 4 from top, alkyl should be changed to alkenyl since the substituents for alkyl are already defined.

In claim 34, page 26, line 1 from top, alkyl should be changed to alkenyl since the substituents for alkyl are already defined.

In claim 35, page 27, line 2 from bottom, alkyl should be changed to alkenyl since the substituents for alkyl are already defined.

In claim 36, page 29, last line, alkyl should be changed to alkenyl since the substituents for alkyl are already defined.

Claims 32 and 33 depend upon non-elected claim 16. An appropriate correction is required.

In claim 34, formula (I) is missing.

Claims 34-36 are essentially duplicate of claim 31. Also, essential steps for converting compounds of formula (III) to (II), (II) to (IV) and then (IV) to (I) are missing in claims 34-36. The applicants are suggested to cancel these claims.

8. In claim 29, after complete, the applicants are suggested to delete –is--- and insert –in--.

Allowable Subject Matter

9. Claims 21-30 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

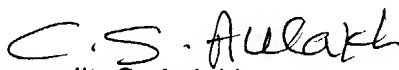
The instant process for preparing compounds of formula (I) is allowable over the prior art since it is neither disclosed nor obvious over the prior art. In the prior art, Gerster (U.S. Patent no. 5,367,076) discloses a process (see columns 3 and 4) for preparing instant compounds of formula (I). However, the process of Gerster differs from the instant process.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charanjit S. Aulakh whose telephone number is (571)272-0678. The examiner can normally be reached on Monday through Friday, 8:30 A.M. to 5:00 P.M..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on (571)272-0699. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Charanjit S. Aulakh
Primary Examiner
Art Unit 1625